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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

BILL L. DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363

Issued May 20, 1997

Serial No. ~~08/515,097~~

§ Group Art Unit: 2854

Filing Date: May 20, 1999

§ Examiner: _____

Serial No.: 09/315,796

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**NOTICE OF LITIGATION INVOLVING '363 PATENT
UNDERGOING REISSUE AND NOTICE OF STAY OF LITIGATION**

TO: Assistant Commissioner of Patents
Washington, D.C. 20231

SIR:

Pursuant to M.P.E.P. 1442.04, notice is hereby given by applicants of litigation involving the captioned '363 patent, styled *Printing Research, Inc. and Howard W. DeMoore v. Williamson Printing Corporation, Bill L. Davis and Jesse S. Williamson*, Civil Action No. 3-99CV1154-D, United States District Court for the Northern District of Texas, Dallas Division ("the Suit"), which action was served on Defendants the day after the instant reissue application was filed. The Suit alleges wrongful inventorship in the '363 patent and that Plaintiff DeMoore is either the sole or joint inventor of the '363 claimed invention. The Suit further alleges infringement of the '363 patent by Defendants, as well as various state causes of action including conversion (Count III), interference with prospective contractual relations (Count IV), and breach of contract (Count V). Very recently the undersigned counsel received the formal filing receipt and, therefore, was in a position to notify the PTO of the Suit. A copy of Plaintiffs' Original Complaint in the Suit is attached in a binder as Exhibit A.

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Defendants responded to Plaintiffs' Original Complaint by filing their Answer on June 10, 1999. (Exhibit B). In their Answer, Defendants deny that DeMoore is an inventor or co-inventor of the '363 patent and assert that Plaintiffs are equitably and administratively estopped to maintain a position of sole inventorship, if not also joint inventorship. In regard to Count II, Defendants assert that Plaintiffs lack standing to bring an action for infringement of the '363 patent, and Plaintiffs have recently indicated in a paper filed in the Suit that this count will be dismissed. Defendants further assert that Plaintiffs have no basis for a claim for infringement because they possess no present ownership interest, *prima facie* title in or immediate or superior right of possession to the '363 patent or any rights to exclude others under the patent. Defendants further denied the factual grounds on which Plaintiffs asserted claims for interference with contractual relations and breach of contract.

On June 11, 1999, Defendants moved to stay the Suit in view of the pending reissue application in order to allow the Patent and Trademark Office ("PTO") to determine patentability of existing claims, as well as to examine newly presented claims directed to embodiment(s) not previously claimed. See Exhibit C. On July 2, 1999, Plaintiffs filed their Response in Opposition to the Motion to Stay, arguing, among other things, that reissue proceedings do not have in their nature the "try[ing]" of inventorship issues. See Exhibit D. On July 6, 1999, the District Court stayed the Suit until the completion of these reissue proceedings. Exhibit E.

Plaintiffs are, of course, wrong with respect to whether the PTO can consider issues of inventorship in a reissue. Note M.P.E.P. 2137 and 2137.01. In addition, the Office has had for many years a standing policy that rejections of claims can be made in any prosecution for wrongful inventorship/derivation pursuant to 35 U.S.C. §§ 102(f) and 102(g). See, for example, "Initial Guidelines Implementing Changes in 35 U.S.C. 103, 116 and 120," 1050 OG 316, 317 (January 8, 1985) and "Final Rules for Miscellaneous Patent Provisions," 1053 TMOG 10, 11 (April 2, 1985).

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Some Comments About the Examination of this case,
Including the Issue of Inventorship

Reissue applicants have brought to the attention of the PTO under supplemental cover a number of patents, U.S. and foreign, and an article cited in U.S. and foreign patent offices with respect to patent applications filed in 1995 (one filed in early May, 1995, and the other four in October 1995) wherein Plaintiffs, and others, disclosed only part of the claimed invention and did not claim reissue applicants' invention. The requisite PTO-1449 forms are attached.

Plaintiffs have a heavy burden – by clear and convincing evidence – to show non-joinder or wrongful inventorship in an issued patent. *Ethicon, Inc. v. United States Surgical Corporation*, 135 F.3d 1456, 1461 (Fed. Cir. 1998); *Hess v. Advanced Cardiovascular Systems, Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997), citing *Garrett Corp. v. United States*, 422 F.2d 874, 880 (ct. Cl. 1970); and *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998). As the *Woodland Trust* panel held:

... [T]here is a very heavy burden to be met by one challenging validity when the only evidence is the oral testimony of interested persons and their friends, particularly as to long-past events.

Id.

That heavy burden can only be discharged by proof that Plaintiff, Printing Research, or its owner, DeMoore, solely or by joint collaboration, participated in the conception of at least one of the '363 claims. *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994). Conception is the touchstone to determine inventorship. *Id.*

The “rule of reason” regarding proofs applies under the “clear and convincing” standard. Plaintiffs must provide substantial and meaningful corroboration of any alleged conception/co-conception with reissue applicants, which is not a trivial requirement. *Hess, supra*. The “clear and convincing” standard as it applies to corroboration in these cases cannot be discharged by the oral testimony alone of the contesting party – here Printing Research and DeMoore. *Thompson S.A. v. Quioxte Corp.*, 166 F.3d 1172, 1175 (Fed. Cir. 1999); *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998); and *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998). As the Federal Circuit recently stated:

[i]n the context of § 102(f) (derivation) and § 102(g) (priority), we have stated that “the case law is unequivocal that an inventor’s testimony respecting facts surrounding a claim of derivation or priority of invention cannot, standing alone, rise to the level of clear and convincing proof.”

Finnigan Corp. v. ITC, ___ F.3d ___, 51 USPQ2d 1001, 1010 (Fed. Cir. 1999).

The strict level of proof required by the Supreme Court in *Washburn & Moen v. Beat’Em All Barbed Wire*, 143 U.S. 275, 12 S.Ct. 443, 36 L.Ed. 154 (1892) applies. *Id.* Reissue applicants contend that without (1) corroboration of a credible witness for Plaintiffs, (2) or submission of corroborated notebooks coupled by transmission of documents to reissue applicants (for joint invention), or (3) the existence of corroborated notebooks or the equivalent for sole inventorship, as a matter of law, the “clear and convincing” burden cannot be met by Plaintiffs.

Printing Research’s own letters to Williamson Printing, assignee of the ‘363 patent, in early 1999 render it susceptible of estoppel in view of its position taken there of joint inventorship. Those letters clearly were written with the advice of counsel, and Printing Research’s change in its position (1999 letters – joint inventorship; Complaint – sole inventorship in DeMoore) illustrates why the burden in these cases is so high. *Woodland Trust, supra.*

The simple fact is that it was perfectly appropriate for reissue applicants to request those of ordinary skill in the art (Printing Research) to construct a device to implement reissue applicants’ invention as a “pair of hands;” such acts of Printing Research in modifying an existing machine for use on a printing station in the continuous in-line printing of reissue applicants’ assignee Williamson Printing by itself does not constitute inventive thought. *Hess, supra; Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985). “[A]n inventor ‘may use the services, ideas and aid of others in the process of perfecting his invention without losing his right to a patent.’” *Hobbs v. United States Atomic Energy Comm’n*, 451 F.2d 849, 864 (5th Cir. 1971).

Printing Research and DeMoore have vacillated all over the page with respect to inventorship, as we shall see – indicating co-inventorship with reissue applicants in letters to applicants this year, claiming sole inventorship in DeMoore in the Complaint, and maintaining still a third position in its patent applications. These inconsistencies adversely reflect on the credibility of Plaintiffs. It is all but apparent that the Suit is an effort to share, if not control, the proprietary rights reissue applicants now have based on whatever theory Plaintiffs chose to assert on a day-to-day basis, regardless of the facts.

Assignee for reissue applicants has submitted to counsel for Plaintiffs the reissue application, except for the materials submitted on a confidential basis, the Petition to Expunge and the Joint Declaration of Bill Davis and Jesse S. Williamson. Exhibit F. On July 16, 1999, Plaintiffs in the Suit filed Plaintiffs' Motion for Reconsideration of, or Certification for Interlocutory Appeal of, the Order Granting Defendants' Motion to Stay and Brief is [sic] Support. Exhibit G.

Respectfully submitted,



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CERTIFICATE OF SERVICE

This is to certify that the foregoing Notice of Litigation Involving '363 Patent Undergoing Reissue and Notice of Stay of Litigation was served on Plaintiffs' counsel of record by placing a true and correct copy in the United States Mail, postage prepaid, on the 26 day of July, 1999, addressed as follows:

William D. Harris, Jr., Esq.
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